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In re Application of FUJII et al
U.S. Application No.: 10/088,488
Int. Application No.: PCT/JP01/06535
Int. Filing Date: 30 July 2001
Priority Date: 28 July 2000
Attorney Docket No.: 020392
For: METHOD FOR PERMITTING
REPRODUCTION OF CONTENT FILE AND
AND RECORDED MEDIUM ON WHICH
REPRODUCTION SOFTWARE FOR
REPRODUCING CONTENT FILE
IS RECORDED

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicant's "Petition Under 37 CFR §1.47(a)" filed 30 July 2002, requesting that the present application be accepted for United States national stage processing without the signature of one of the joint inventors.

BACKGROUND

On 30 July 2001, applicant filed international application PCT/JP01/06535, which claimed priority of an earlier Japan application filed 28 July 2000. A copy of the international application was communicated to the USPTO from the International Bureau on 07 February 2002. A Demand for international preliminary examination, in which the United States was elected, was not filed prior to the expiration of nineteen months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2002.

On 26 March 2002, applicant filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 June 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 30 July 2002, applicant filed a declaration along with the present petition under 37 CFR 1.47(a)

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by joint inventor Akira Matsubara on his own behalf and on behalf of the nonsigning inventor Bunichiroh Fujii.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The present petition states that joint inventor Fujii refuses to sign the application papers. The petition states that Fujii communicated his refusal to sign in an electronic mail message from Fujii to Yuka Naruse and in an electronic mail message from Fujii to Eriko Uchida. However, a

review of the message from Fujii to Naruse reveals that while Fujii expressed hesitation with respect to patenting the invention, Fujii's statements fell short of refusing to cooperate. Similarly, a review of the message from Fujii to Uchida reveals that Fujii may not understand company policy but does not adequately signify Fujii's refusal to sign. Moreover, even if the respective messages to Naruse and Uchida were deemed sufficient evidence of Fujii's refusal to sign, applicant has not provided affidavits from the persons to whom the purported refusal was made as required by MPEP 409.03(d). Statements based on hearsay will not be accepted. Thus, it would be unreasonable to conclude at the present time that Fujii refuses to join in the application.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

Because applicant has failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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